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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,182	03/06/2001	John Philipson	35682-8002US	4103

25096 7590 03/14/2006

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EXAMINER

TOOMER, CEPHIA D

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/801,182

Applicant(s)

PHILIPSON, JOHN

Examiner

Cephia D. Toomer

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,9-23,27-29,33-41 and 44-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,3-6,9-23,27-29,33-41,44-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 23, 2005 has been entered.
2. This Office action is in response to the amendment filed December 23, 2005 in which claims 1 and 18 were amended and claims 51 and 52 were added.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
2. Claims 1, 18 and their dependents are rejected under 35 U.S.C. 112, first paragraph, for the reasons of record as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

3. The language “approximately or completely free of glass, metals, plastics and paper” is not supported by the original filed specification.

4. Applicant argues that there is support for the phrase “approximately or completely free of glass, metals, plastics and paper.” Applicant relies upon page 7, lines 25-26 to support this argument. Applicant argues that the Examiner has misunderstood or misinterpreted the requirements of 35 USC 112, first paragraph.

The examiner respectfully disagrees. The specification states that the solid waste is free or essentially free of hazardous waste. Glass, metals, plastics and paper are not considered hazardous waste. The specification also teaches that “in addition the municipal solid waste should be free of or have a low content of recyclable materials.” The term “low” as it refers to the amount of the recyclable material present in the solid waste does not particular point out how much of the solid waste material is recyclable materials nor that Applicant had possession of municipal waste that was approximately free of recyclable materials. Is low 1%, 5%, 10%? Since Applicant provides no guidance as to how much of the material would be considered a low amount, Applicant did not have possession of the claimed invention. The claimed language “approximately free of” and the written description language “have a low content” are not synonymous.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 52 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim is rejected because "low" is a relative term that does not have a comparative value.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3-6, 9-17, 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sprules (US 6,113,662).

Sprules teaches a fuel pellet comprising at least 50% spent dried coffee grounds (municipal solid waste), a combustible wax (hydrocarbon material), a coking agent and/or a cellulose material (wood, leaves, etc) (see abstract; col. 2, lines 50-52, 64-66; col. 3, lines 37-44; col. 10, lines 39-59).

Sprules teaches that coffee grounds are clean burning and are less likely to produce polycyclic aromatic hydrocarbons during combustion (see col. 3, lines 24-36). Sprules teaches that the use of coffee grounds as a fuel source diverts waste from landfills (see col. 3, lines 61-63).

Table 1 shows that the coffee grounds have a heat value of 10,218 BTU/lb, moisture of 2.09 and ash content of 0.84wt%. Table 4 shows that the wax has a

heating value of 18,000 BTU and wood has a heating value of 8,000 BTU. Sprules teaches the limitations of the claims other than the differences that are discussed below.

In the first aspect, Sprules differs from the claims in that he does not specifically teach the heating value of the fuel pellet. However, it would have been obvious to one of ordinary skill in the art to produce a fuel pellet possessing a fuel value of 10,000-14,000 BTU (claims 1 and 11-13) because Sprules teaches that the coffee grounds have a fuel value of 10,000 BTU, the wax has a heating value of 18,000 BTU and wood has a heating value of 8,000. Given these values and Sprules teaching that the fuel pellet contains at least 50% and up to 75% of the coffee ground, it would have been obvious to one of ordinary skill in the art to optimize these result effective variables to obtain fuel pellets that produce a hotter, cleaner burning fuel that releases fewer harmful pollutants and provides a brighter flame over a longer period of time (see abstract; Tables 1-4).

In the second aspect, Sprules differs from the claims in that he does not specifically teach that the solid waste is in the form of a fluff (claims 1 and 18). However, no unobviousness is seen in this difference because regardless of the form of the solid waste a fuel pellet will form. Applicant's choice of fluff as the form of the solid waste is merely a design choice. It is well settled that changes in size/proportions and shape is prima facie obvious if the claimed products do not perform differently from the prior art. In the instant case, the fuel pellets of the present invention perform the same function as the fuel pellets of Sprules. See MPEP 2144.04 IV(A and B).

In the third aspect, Sprules differs from the claims in that he does not teach the emissions properties of claim 9. However, given that Sprules teaches fuel pellets that contain no hazard waste, it would be reasonable to expect that the fuel pellets emissions would possess similar properties, absent evidence to the contrary.

In the fourth aspect, Sprules differs from the claims in that he does not specifically teach the size and shape of the fuel pellets. However, it is well settled that changes in size/proportions and shape is prima facie obvious if the claimed products do not perform differently from the prior art. In the instant case, the fuel pellets of the present invention perform the same function as the fuel pellets of Sprules. See MPEP 2144.04 IV(A and B).

9. Applicant's arguments have been fully considered but they are not persuasive.
10. Applicant argues that Municipal waste is characterized in the present application as waste that "may contain a wide variety of waste or discarded material" (specification at page 7, lines 3-4). Such waste "may include biodegradable waste, non-biodegradable waste, ferrous materials, non-ferrous metals, paper or cardboard in a wide variety of forms, a wide range of plastics (some of which may contain traces of toxic metals used as catalysts, stabilizers or other additives), paints, varnishes and solvents, fabrics, wood products, glass, chemicals including medicines, pesticides and the like, solid waste of various types and a wide range of other materials" (specification at page 7, lines 3-10). The foregoing representative (e.g., non-exhaustive) characterization of municipal waste is consistent with the commonly accepted use of the term as referring to a solid waste stream generated by a typical municipality. Applicant

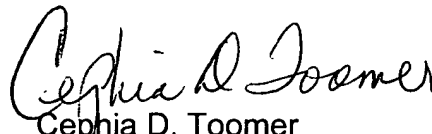
argues that Sprules fails to teach the present invention because the fuel of Sprules includes at least 50% dried coffee grounds obtained from food processing establishments. Applicant states that it is unreasonable to believe that any municipal solid waste stream would contain at least 50% dried spent coffee grounds.

11. Applicant defines Municipal Solid Waste (MSW) as waste that may contain a wide variety of waste or discarded material. Such waste may include ...and a wide range of other materials. This definition is exemplary at best. "May contain" and "may include" is language that sets forth examples of materials that may or may not be present. The EPA defines MSW as trash or garbage. Spent coffee grounds from food processing establishments falls under the category of trash or garbage.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Cepha D. Toomer
Primary Examiner
Art Unit 1714

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